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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Atico International USA, Inc.

Serial No. 75/418,428

Peter T. Cobrin of Cobrin & Gittes for Atico International
USA, Inc.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office
104 (Sidney I. Moskowitz, Managing Attorney).

Before Cissel, Wendel and Rogers, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Atico International USA, Inc. has filed an application
to register the mark EASY DECOR for "electrical decorative
lights sold in retail outlets."¹

Registration has been finally refused under Section
2(d) of the Trademark Act on the ground of likelihood of

¹ Serial No. 75/418,428, filed January 15, 1998, based on an
allegation of a bona fide intent to use the mark in commerce.
A disclaimer has been made with respect to the word DECOR.

confusion with the mark depicted below, which has been registered for "electrical receptacle for multiple inputs."²

The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont* factors³ which are relevant under the circumstances at hand. Two key considerations in our analysis are necessarily the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods in connection with which the marks are being used, or are intended to be used. See *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

As for the present marks, the Examining Attorney maintains that the dominant portion of registrant's mark is E-Z DECOR, and as such is the phonetic equivalent of applicant's mark, EASY DECOR. She argues that the

² Registration No. 1,801,407, issued October 26, 1993. Section 8 & 15 affidavits have been accepted and acknowledged, respectively. A disclaimer has been made of the word OUTLET.

³ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

remaining term in registrant's mark, the word OUTLET, being the generic name for registrant's goods and also being disclaimed matter, has minimal trademark significance. She also gives little weight to the design features of registrant's mark, arguing that it is the literal portion of the mark which will be used by consumers in calling for the goods.

Applicant contends that, notwithstanding any phonetic similarity, when considered in their entireties, the two marks are clearly dissimilar in overall appearance. Applicant notes that there are three "formatives" in registrant's mark, as well as a "distinctive" design element, as opposed to the plain type style in which applicant's mark is presented. Applicant insists that the term OUTLET is both the visually dominant portion of registrant's mark and the term likely to be remembered by consumers and emphasized when the mark is pronounced. Applicant further argues that the marks create different commercial impressions, because the connotation of E-Z, as presented in registrant's mark, is not the same as EASY in applicant's mark. Specifically, applicant argues that the E-Z in "stressed" lettering in registrant's mark is indicative of the electrical function of registrant's outlet and the connotation of the mark as a whole is of a

"decorative electrical outlet," whereas the EASY of applicant's mark refers to the ease with which its decorative lights are assembled.

Although it is true that in determining likelihood of confusion, marks must be considered in their entirety, it is also well established that there is nothing improper in giving more or less weight to a particular feature of a mark. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Although disclaimed matter cannot be ignored, the fact remains that purchasers are more likely to rely upon the non-descriptive portions of the mark as the indication of source. See Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993). Design elements also may be of lesser import, because it is generally the word portion of a mark, rather than any design feature, unless highly distinctive, which is more likely to be remembered and relied upon by purchasers in calling for the goods. See In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987).

We agree with the Examining Attorney that E-Z DECOR is the dominant portion of registrant's mark. As shown by the dictionary definition made of record by the Examining Attorney, the term "outlet" is a generic term for an electrical receptacle and, as such, has no source

indicating significance. The words E-Z DECOR are what would be used by purchasers to refer to, or call for, the goods. The design is more likely to be perceived as a representation of the strip receptacle and not as an indication of source. See *In re Appetito Provisions Co.*, *supra*.

Furthermore, applicant has provided no basis for us to conclude that the use of "stressed" lettering for E-Z in registrant's mark converts the connotation of this term to "electrical," in contrast to the generally recognized meaning of E-Z as a shortened form of the word "easy." Accordingly, we find that not only are the dominant portions of the two marks, E-Z DECOR and EASY DECOR, phonetic equivalents, but also the overall commercial impressions created by the marks are very similar.

Thus, we turn to the issue of the similarity or dissimilarity of the respective goods. We are guided by the well-established principle that it is not necessary that the goods of applicant and registrant be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that

could, because of the similarity of the marks used therewith, give rise to the mistaken belief that they emanate from, or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein.

Here, the Examining Attorney argues that the goods are related in that they are complementary, i.e., applicant's decorative lights are operated by plugging them into an electrical receptacle such as registrant's. In addition, she points to third-party registrations in which the same marks are registered for both electrical lights and fixtures and electrical outlets/receptacles as evidence that the same companies manufacture and/or sell both types of goods. On the basis of this evidence, she concludes that purchasers would be likely to believe that both types of goods emanate from the same source, if highly similar marks are used thereon.

Applicant strongly contends that the goods are not related. As support for its position, applicant has introduced the declaration of Martin Sutker, Vice President of Marketing for applicant, a person claiming to have extensive experience in merchandising all types of consumer goods to retail stores, including electrical products such as decorative lights and receptacles with multiple outlets.

In his declaration, Mr. Sutker states, inter alia:

6. Retail outlets place electrical decorative lights in the lighting section of the store and electrical receptacles with multiple inputs in the electrical hardware section of the store. These generally are in different locations.

9. Electrical receptacles with multiple inputs can be used for connecting electrical decorative lights to a source of power because the electrical receptacles are built for general purpose connectivity with electrical equipment having plugs and the electrical receptacle sockets are compatible with electrical decorative light plugs as well [as] electrical plugs for other electrical devices.

10. Electrical decorative lights are generally for festive or holiday occasions and require only a single electrical socket since they usually have only one electrical plug.

11. Purchasers who buy an electrical decorative light set have no practical reason to go to the expense of purchasing an electrical receptacle with multiple inputs as the electrical decorative light generally has but a single electrical plug.

12. The market for electrical decorative lights is separate and distinct from the market for electrical receptacle with multiple inputs and if both types of products have similar or phonetically identical marks there would be little or no likelihood of confusion in the marketplace among purchasers or retailers.

13. In the event one or the other type of product fails and requires replacement, a consumer would seek repair or replacement of the particular product itself, without regard to the trademark appearing on any other product.

14. In my opinion, retailers are generally aware that electrical decorative lights are not supplied by the same supplier as electrical receptacles with multiple inputs and similarities in the trademarks used to identify each product would not change this perception, unless both were packaged and sold together as a unit.

Relying on these statements, applicant argues that the goods are unrelated; that registrant's receptacles are clearly not designed specifically for use with applicant's

decorative lights. Applicant further argues that the channels of trade are different, since the products would be sold in separate sections of a retail outlet.

Applicant also contends that of the thirteen third-party registrations made of record by the Examining Attorney, only two identify the electric light goods covered thereby as "electric string lights," goods said to be similar to those of applicant, and only one identifies the receptacles or outlets as those for multiple inputs. Thus, applicant argues, the evidence submitted by the Examining Attorney fails to contradict statements made in the Sutker declaration to the effect that the two types of products involved here are not supplied by the same supplier.

The Examining Attorney has challenged the probative weight which may be given to the Sutker declaration as a whole, in view of the conclusory statements made therein, particularly those in paragraphs 11-14. While we are in total agreement that the statements made with respect to the ultimate issue of likelihood of confusion or opinions expressed with respect to purchaser or supplier perception of trademarks extend beyond the scope of Mt. Sutker's personal knowledge or expertise, we have given weight to those factual statements directed to the specific nature

and manner of use of the goods involved here. See *In re Helene Curtis Industries, Inc.*, 143 USPQ 456 (TTAB 1964). Even so, we find the evidence as a whole demonstrates that a complementary relationship exists between the goods, namely, that the decorative lights of applicant could be plugged into the electrical receptacles of registrant. Applicant has acknowledged as much in paragraph 9 of the Sutker declaration. The fact that registrant's receptacles may used for other purposes is immaterial; applicant's decorative lights still may use a means such as registrant's for connection to a power source. Furthermore, although a single string of decorative lights has only one plug, it is only reasonable to assume that more than one string of decorative lights might be used at the same time, requiring use of a multiple input receptacle. Although applicant stresses that the decorative lights and the receptacles would normally be located in different sections of a retail outlet, this does not detract from the fact that purchasers might well purchase both items on a single shopping trip for use together. The question is whether, in view of this potential for use together, these purchasers would be likely to mistakenly believe that both products originate

from the same source, if similar marks are used therewith. This record shows they would.

We place little weight in Mr. Sutker's opinion that retailers would not expect both types of products to be supplied by the same source, unless packaged together. In the first place, this is only declarant's opinion, unsupported by objective evidence. Second, it is the ultimate purchasers of the products with whom we are concerned. In this regard, we find the third-party registrations relied upon by the Examining Attorney adequate to establish that these are the type of goods which may be produced by a single entity, and thus purchasers encountering both products might reasonably assume that they emanate from a single source. See *In re Albert Trostel & Sons Co.*, *supra*; *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988).

Although applicant argues that the majority of these registrations are not for "electric string light" or lights for festive occasions, as pointed out by the Examining Attorney, neither are applicant's "decorative lights" so restricted. Thus, we see no reason not to consider registrations covering electric lamps, electric garden lights and the like. Under similar reasoning, although most of the registrations simply identify the electrical

outlets as "receptacles" or "outlets" without any specification of "multiple inputs," we agree with the Examining Attorney that such products may be assumed to encompass receptacles similar to registrant's.

Accordingly, the Examining Attorney's reliance upon the third-party registrations is well taken. We find the evidence of record fully adequate to establish that a viable relationship exists between the goods, so that the use of similar marks thereon would be likely to result in confusion as to source.

Although applicant argues that the channels of trade differ for the goods, applicant relies solely on the statement of Mr. Sutker that the products would be sold in separate sections of a store to support this claim. Separate sections of the same retail outlets do not necessarily qualify as different channels of trade. The products are offered to the same class of purchasers, are made available in the same type of commercial enterprise, and may even be bought at the same time. The channels of trade are identical. Similarly, even though applicant's lights may be found in the lighting section and registrant's receptacles in the electrical hardware section, the conditions for sale are not different. Both are offered to the same purchasers under the same retail

conditions; the difference in location within the store is not a difference in condition of sale or marketing.

Accordingly, upon a review of all relevant *du Pont* factors, and particularly upon consideration of the overall similarity of the marks and the complementary relationship which exists between the goods, we find that confusion would be likely if applicant were to use its mark on the goods set forth in the application.

Decision: The refusal to register under Section 2(d) is affirmed.

R. F. Cissel

H. R. Wendel

G. F. Rogers

Administrative Trademark Judges,
Trademark Trial and Appeal Board

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